

Comments on the Request for Information

The Action includes a Request for Information pursuant to 37 CFR § 1.105 ("Request").

The Request is improper because it is unclear

The scope of the requirement is not narrowly defined, as is required in accordance with MPEP § 704.11. What constitutes the information requested is unclear, especially in light of the claimed invention being novel and nonobvious. As best understood, the Action requests:

- I. "each publication that any of the applicants relied upon to develop . . . the technology disclosed in the claimed invention".

The Request is improper because it is not timely

MPEP § 704.11(b) makes clear that "a request for information should *not* be made with or after" prosecution is closed. MPEP § 704.11(b)(III) confirms that "A requirement for information is *not* proper when no further action would be taken by the examiner. The reasonable necessity *criteria* for a requirement for information implies further action by the examiner". In Applicant's application, prosecution was closed with the Quayle Action. The Quayle Action is evidence that there isn't any implication of further action by the examiner. In accordance with the Office's own procedures, the Request is improper and should be withdrawn.

The Request is improper because the information requested is not reasonably necessary

Applicants respectfully submit that the Request is improper because the information requested is not reasonably necessary to properly examine or treat a matter in the current application. Thus, the Request should be withdrawn.

MPEP § 704.11 makes clear that "a requirement under 37 CFR 1.105 may *only* be made when the examiner has a reasonable basis for requiring information". The criteria "for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application". The legal criteria of reasonable necessity is met where:

- (A) The claimed subject matter cannot be adequately searched. This instance occurs where the invention as a whole is in a new area of technology which lacks any patent classification.

Applicants' application has already been searched. Nor is the application in a new area of technology. Thus, the Office has not met criteria (A).

- (B) The application file justifies asking for information. This instance occurs where the application file *itself* suggests the applicants have access to information necessary to a more complete understanding of the invention.

The Office has not cited any part of the application file that points to the applicants having additional information. Nor has the Office shown that the invention is so complex that a more complete understanding thereof is needed by the examiner. Thus, the Office has not met criteria (B).

As can be seen, the Office has not met either (A) or (B). It follows that the Office has not met the legal criteria for imposing the Request.

Furthermore, a "reasonable necessity *criteria* for a requirement for information implies further action by the examiner" (MPEP § 704.11(b)(III)). As already discussed, the Quayle Action closed prosecution. The Quayle Action is evidence against any implication of further action by the examiner. Again, the Office has not met the prerequisite criteria for imposing the Request.

Applicants' Comments constitute a complete reply to the Request

The party or parties from which information was requested do not recall relying on any prior art publications to develop the technology disclosed in the claimed invention. Thus, at present it is inherently unknown and/or not readily available to the party or parties. It is respectfully submitted that no other comments by Applicants are deemed necessary with regard to the Request (as it is best understood).

Comments on the Statement of Reasons for Allowance

Applicants acknowledge the Office's admission that the pending claims are patentable over the references of record. Applicants respectfully submit that while the specific features and relationships mentioned in the statement of reasons for allowance are not disclosed or suggested in the prior art, these are not the only recited features and relationships which are not found in the prior art. Furthermore, the statement sometimes indicates a general paraphrasing of claim language, and not necessarily the exact claim language. The statement also refers to subject matter (or language) which is not recited in all of the claims. For example, but not necessarily all-inclusive, not all claims require a resilient tab portion "biased away from a picking member". It should be understood that the allowed subject matter is to only be limited by that subject matter which is recited. Any remarks in the statement which narrow the recited subject matter should be disregarded.

Conclusion

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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